

REMARKS

Pursuant to the present amendment, claims 1, 9, 14, 19 and 22 have been amended, claims 5, 10, 15, 20 and 23 have been canceled, and new claims 66-84 have been added. Thus, claims 1-2, 4, 6-9, 11-14, 16-19, 21, 22, 24-30 and 66-84 are pending in the present application. No new matter has been introduced by way of the present amendment. Reconsideration of the present application is respectfully requested.

In the Final Office Action, claims 28-30 were allowed. Claims 5, 10, 15, 20 and 23 were indicated to be allowable if rewritten in independent form. Pursuant to the present amendment, independent claims 1, 9, 14, 19 and 20 have been amended to include the limitations from now-canceled dependent claims 5, 10, 15, 20 and 23, respectively. Accordingly, it is believed that claims 1-2, 4, 6-9, 11-14, 16-19, 22 and 24-27 are likewise allowable. In summary, all pending claims, other than new claims 66-84, are believed to be either allowed or in condition for allowance.

In the Final Office Action, the Examiner issued rejections based upon Gessaman (U.S. Patent Publication No. 2004/0099832) and Steinke (U.S. Patent No. 6,024,122). In view of the amendments made herein, it is believed that the Examiner's rejections are moot. It should be understood that in making the amendments set forth herein, Applicants do not acquiesce in the appropriateness of the Examiner's rejections. Applicants specifically reserve the right to pursue claims of the scope set forth in the rejected claims in a later filed application should they desire to do so.

As the Examiner well knows, an anticipating reference by definition must disclose every limitation of the rejected claim in the same relationship to one another as set forth in the claim. *In re Bond*, 15 U.S.P.Q.2d 1566, 1567 (Fed. Cir. 1990). To the extent the Examiner relies on principles of inherency in making the anticipation rejections in the Office Action, inherency

requires that the asserted proposition necessarily flow from the disclosure. *In re Oelrich*, 212 U.S.P.Q. 323, 326 (C.C.P.A. 1981); *Ex parte Levy*, 17 U.S.P.Q.2d 1461, 1463-64 (Bd. Pat. App. & Int. 1990); *Ex parte Skinner*, 2 U.S.P.Q.2d 1788, 1789 (Bd. Pat. App. & Int. 1987); *In re King*, 231 U.S.P.Q. 136, 138 (Fed. Cir. 1986). It is not enough that a reference could have, should have, or would have been used as the claimed invention. “The mere fact that a certain thing may result from a given set of circumstances is not sufficient.” *Oelrich*, at 326, quoting *Hansgirg v. Kemmer*, 40 U.S.P.Q. 665, 667 (C.C.P.A. 1939); *In re Rijckaert*, 28 U.S.P.Q.2d 1955, 1957 (Fed. Cir. 1993), quoting *Oelrich*, at 326; see also *Skinner*, at 1789. “Inherency ... may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.” *Skinner*, at 1789, citing *Oelrich*. Where anticipation is found through inherency, the Office’s burden of establishing *prima facie* anticipation includes the burden of providing “...some evidence or scientific reasoning to establish the reasonableness of the examiner’s belief that the functional limitation is an inherent characteristic of the prior art.” *Skinner* at 1789.

Moreover, to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant’s disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991); M.P.E.P. § 2142. Moreover, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (CCPA 1974). If an independent claim is nonobvious under 35

U.S.C. § 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988); M.P.E.P. § 2143.03.

With respect to alleged obviousness, there must be something in the prior art as a whole to suggest the desirability, and thus the obviousness, of making the combination. *Panduit Corp. v. Dennison Mfg. Co.*, 810 F.2d 1561 (Fed. Cir. 1986). In fact, the absence of a suggestion to combine is dispositive in an obviousness determination. *Gambro Lundia AB v. Baxter Healthcare Corp.*, 110 F.3d 1573 (Fed. Cir. 1997). The mere fact that the prior art can be combined or modified does not make the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1990); M.P.E.P. § 2143.01. The consistent criterion for determining obviousness is whether the prior art would have suggested to one of ordinary skill in the art that the process should be carried out and would have a reasonable likelihood of success, viewed in the light of the prior art. Both the suggestion and the expectation of success must be founded in the prior art, not in the Applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991); *In re O'Farrell*, 853 F.2d 894 (Fed. Cir. 1988); M.P.E.P. § 2142.

New claims 66-84 are presented for prosecution in the present application. Support for claims 66-84 may be found throughout the specification. See, e.g., Figures 2, 3A; p. 11, l. 8 – p. 13, l. 25; p. 15, l. 24 – p. 17, l. 12. By way of example, independent claim 66 recites that the valve stem has a second end with an end face and a sealed cavity that allows the pressure of the working fluid to be exerted in the sealed cavity on the entirety of the end face. Independent claims 75 and 81 are narrower in at least some aspects relative to claim 66.

It is respectfully submitted that the prior art of record is very far afield from the inventions set forth in claims 66-84. In Gessaman, the pressure of the working surface is not exerted on the entirety of the end surface of the stem that is not coupled to the valve element. In

fact, it does not appear that there is any flow path disclosed in the valve in Gessaman whereby the pressure of the working fluid could be exerted on the end face of the stem. In Gessaman, the pressure balancing (to whatever extent it is achieved) is accomplished by acting an annular shoulder of the valve stem (*e.g.*, surface 46 within chamber 50) on a surface 60 (that is part of a piston 58). ¶¶ 21-23. Suffice it to say that, at no point does Gessaman even remotely disclose or suggest the inventions set forth in claims 66-84.

Steinke was only cited by the Examiner for purposes of establishing that the prior art disclosed providing filters on the fluid opening. However, Steinke cannot cure the fundamental deficiencies in Gessaman.

In view of the foregoing, it is respectfully submitted that all pending claims are in condition for immediate allowance. The Examiner is invited to contact the undersigned attorney at (713) 934-4055 with any questions, comments or suggestions relating to the referenced patent application.

Respectfully submitted,

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